

#### **REJECTION UNDER 35 U.S.C. § 102 AND 103**

Claims 1-7, 16-18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by White et al. (U.S. Pat. No. 6,416,553; hereinafter "White"). Claims 16-23, and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Doursonian et al. (U.S. Pat. No. 6,527,809; hereinafter "Doursonian"). Claims 8-15, 24 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Doursonian in view of Lennox (U.S. Pat. No. 5,507,824; hereinafter "Lennox"). These rejections are respectfully traversed.

Applicant respectfully submits that support for the amendments, including new Claims 34 and 35, herein can be found in the application as filed at least in Figs. 21-27 and the related description. New Claims 34 and 35 depend from independent claims that, as argued below, should be in condition for allowance. At least for this reason Claims 34 and 35 should also be in condition for allowance

Independent Claim 1 has been rejected as anticipated by White et al. White et al. is directed to a modular acetabular prosthesis. The modular acetabular prosthesis of White et al. can include, as exemplary illustrated in Figs. 1 and 2, a bearing liner 14, locking ring 16, and acetabular cup 12. Other modular portions can include a modular flange 18, a modular blade 20, and a modular obturator hook 22. See, White et al., col. 5, lns. 27-30.

Independent Claim 1, contrary to White et al., has been amended to recite, "an acetabular prosthesis having a threaded receiving bore; a trial bearing liner; a plurality of attachment passages defined by the trial bearing liner each attachment passage located a different distance from an apex of said trial bearing liner; and an attachment

member having a length to pass through at least one of the attachment passages and interconnect the acetabular prosthesis at said threaded receiving bore and the trial bearing liner; wherein the attachment member . . . wherein said trial bearing liner is only moveable to rotate around an axis defined by said attachment member." Applicant respectfully submits that White et al. does not anticipate an acetabular prosthesis and trial bearing liner defining attachment passages. Initially, Applicant respectfully submits that the bearing liner 14, illustrated in Fig. 2 of White et al., does not include passages. In addition, White et al. discloses an annular lip 112 that includes arcuate notches 114 to nestingly mate with arcuate alignment tabs 34. Accordingly, the bearing liner 14 would not rotate within the cup 12 as recited in Independent Claim 1. Accordingly, Applicant respectfully submits that Independent Claim 1, and all of the claims that directly or indirectly from Independent Claim 1 are in condition for allowance.

Independent Claim 4 is rejected as anticipated by White et al. Applicant respectfully submits that White et al., however, does not anticipate "a trial bearing liner or trial shell defining an attachment passage therethrough; an attachment member . . . and a lock ring to engage said attachment member to couple said attachment member to either said trial bearing liner or trial shell prior to the attachment member moving to the locating position or the fastened position; wherein said trial bearing liner or trial shell is only moveable to rotate around an axis defined by said attachment member." As discussed above, Applicant respectfully submits that the bearing liner 14 does not rotate relative to the cup 12 in White et al. Further, Applicant respectfully submits that White et al. does not anticipate a system comprising a trial bearing liner or a trial shell, as recited in Independent Claim 4, with the passage therethrough. Finally, White does not

anticipate a locking member that couples an attachment member to either of a trial bearing liner or a trial shell. Accordingly, Applicant respectfully submits that White et al. does not anticipate Independent Claim 4 or any of the claims that depend directly or indirectly therefrom.

Independent Claim 8 is rejected under the combination of Doursonian et al. in view of Lennox. Initially, Applicant notes that Doursonian discloses a cup 16 that is fixed in the acetabular cavity with screws, which are engaged through holes in the cap. A trial insert 33 includes the central orifice 34 which is later replaced with a final insert 38 that does not include the central orifice 34. Additionally, the trial insert 33 includes the central orifice 34 to permit access to the connecting screw 32 that interconnects an external cap 10 and an internal plate 25. See, Doursonian et al., col. 3, Ins. 20-40. The trial insert 33, however, does not move relative to the cup 16, but rather the cup 16 is moved relative to the external cap 10 and the internal plate 25. See, Doursonian et al., col. 4, Ins. 23-35. When the correct orientation is determined, the cup 16 is immobilized relative to the cap 10 by tightening the screw 32. After this, the trial insert 33 is removed and the final insert 38 positioned in the cup 16. See, Doursonian, col. 4, Ins. 36-57. Lennox is directed to a system that includes a selectable insert for defining a selected angle relative to an acetabular prosthesis.

Neither Doursonian et al. nor Lennox, either alone or in combination, anticipate or fairly render obvious a system including a first trial bearing liner and a second trial bearing liner as recited in Independent Claim 8. In this regard, Independent Claim 8 recites, "a first trial bearing liner . . . a second trial bearing liner . . . wherein said first trial bearing liner plane is oriented at a first angle relative to an acetabular cup plane defined by an

acetabular cup upper rim in said locating position and said second trial bearing liner plane is oriented at a second angle relative to said acetabular cup plane in said locating position; wherein said second angle is different from said first angle." As discussed above, Applicant respectfully submits that the trial insert 33 of Doursonian does not rotate around an axis defined by an attachment member as recited in Independent Claim 8. Further, Doursonian does not disclose a first trial bearing liner and a second trial bearing liner each having an upper rim that defines a plane and the passage extending therethrough. Rather, Doursonian discloses an insert 33 that is positioned in the cup 16 simply to allow for moving the cup 16 relative to an external plate. Lennox does not overcome the failings of Doursonian as Lennox only discloses inserts to be positioned in an acetabular prosthesis, even if a plurality is provided. The first and second trial bearing liner with the attachment member as recited in Claim 8 allow for the formation of different angles, as recited in Independent 8, between the trial bearing liner and the acetabular prosthesis, which is not disclosed in Doursonian et al. nor Lennox. Accordingly, Independent Claim 8, and each of the claims that depend directly or indirectly therefrom, are in condition for allowance.

Independent Claim 12 is also rejected as obvious in light of Doursonian et al. and Lennox. Applicant respectfully submits, however, that similar to Independent Claim 8, Independent Claim 12 recites, "a first trial bearing liner defining a first trial bearing liner plane in part by defining a first attachment throughbore at a first position offset a first radial distance from a first apex of the first trial bearing liner; a second trial bearing liner defining a second trial bearing liner plane in part by defining a second attachment throughbore at a second position offset a second radial distance different from the first

radial distance from a second apex of the second trial bearing liner." As discussed above, Doursonian et al. only discloses the trial insert which does not include a first or second attachment throughbore or an attachment member positionable through the respective attachment throughbore, as recited in Independent Claim 12. Rather, Doursonian et al. only discloses a single trial insert 33 that has a passage that allows for the outer plate 10 to be positioned relative to the cup 16. Lennox does not overcome the failings of Doursonian et al. as Lennox only discloses multiple inserts to be positioned in an acetabular prosthesis. Further, neither of the two references, Doursonian et al. nor Lennox, disclose first and second trial bearing liners that have first and second attachment throughbores that are positioned at locations offset from an apex of the respective first and second trial bearing liners. Accordingly, Independent Claim 12, and all the claims that depend therefrom, are in condition for allowance.

Independent Claim 16 is rejected as anticipate by both White et al. and Doursonian et al. Independent Claim 16 has been amended to recite, "a trial bearing liner defining an attachment passage; an attachment member . . . to . . . interconnect said trial bearing liner to said acetabular prosthesis via said attachment passage; and . . . an acetabular cup defining a portion of a hollow sphere and defining a threaded bore surrounded by a depression . . . : wherein said attachment member passes through and engages said attachment passage in said trial bearing liner and said threaded bore in said acetabular cup." As discussed above, Applicant respectfully submits that neither White et al. nor Doursonian et al. anticipate a trial bearing liner defining an attachment passage and an attachment member to interconnect the trial bearing liner in an acetabular prosthesis. In addition, Applicant respectfully submits that neither White et

al. nor Doursonian et al. disclose a depression surrounding a bore that the attachment member engages, as recited in Independent Claim 16. Accordingly, Independent Claim 16 and the claims that depend therefrom are in condition for allowance.

Independent Claim 19 is rejected as anticipated by Doursonian et al. Independent Claim 19, however, recites, "an acetabular prosthesis having a threaded bore formed in a wall of the acetabular prosthesis; a trial bearing liner defining an attachment throughbore; an attachment member . . . to . . . interconnect said trial bearing liner to said acetabular prosthesis via said attachment throughbore; and a lock ring . . . wherein said attachment member includes . . . an attachment end engageable with the threaded bore formed in said acetabular prosthesis." As discussed above, Applicant respectfully submits that Doursonian et al. does not anticipate a trial bearing liner that includes an attachment throughbore through which an attachment member interconnects the trial bearing liner with an acetabular prosthesis. Moreover, Applicant respectfully submits that Doursonian et al. does not disclose a locking member to engage an attachment member to couple the attachment member to a trial bearing liner, as included in Independent Claim 19. As illustrated in Doursonian, the external plate 10 and internal member 25 are interconnected with the cup 16 and the passage 34 does not engage the screw 30.

Further, Independent Claim 19 recites that a threaded throughbore is formed in said acetabular prosthesis that is engageable with the attachment member. As clearly illustrated and discussed above regarding Doursonian et al., the screw engages an external plate 10 and not the cup 16. Accordingly, Independent Claim 19, and the claims that depend directly and indirectly therefrom, are in condition for allowance.

Independent Claim 23 has been rejected as anticipated by Doursonian et al. Independent Claim 23, however, has been amended to recite, "rotating said first trial bearing liner around said throughbore axis to form a plurality of trialing orientations between said acetabular plane and said first trial liner plane; fixing said first trial bearing liner at one of said trialing orientations with an attachment member that selectively couples said first trial bearing liner to the acetabular prosthesis." As discussed above, the trial insert 33 of Doursonian does not move relative to the cup 16. Rather, the cup 16 moves relative to the external plate 10. Accordingly, Doursonian can not anticipate selecting a first trial bearing liner and rotating the first trial bearing liner to form a second trialing angle between the acetabular plane and the first trial liner plane, as recited in Independent Claim 23. Accordingly, Independent Claim 23, and all of the claims that depend directly or indirectly therefrom, are in condition for allowance.

Finally, Independent Claim 28 has been rejected as anticipated by Doursonian et al. Independent Claim 28, however, has been amended to recite, "disposing a first trial bearing liner in said implanted acetabular prosthesis, said first trial bearing liner having an outer dimension defining a first plane and extending at a first angle relative to said implanted acetabular prosthesis; rotating said first trial bearing liner around a first attachment passage axis to generate a first orientation . . . replacing said first trial bearing liner with a second trial bearing liner . . . said second trial bearing liner having an outer dimension defining a second plane and extending at a second angle relative to said acetabular cup plane due to a second attachment passage axis." Initially, as discussed above, Doursonian et al. discloses only a single trial insert 33. Further, the single trial insert 33 does not move relative to the cup 16. Accordingly, Applicant

respectfully submits that Doursonian et al. can not anticipate disposing a first trial bearing liner and replacing the first trial bearing liner with a second trial bearing liner, as recited in Independent Claim 28. Further, Doursonian et al. can not anticipate rotating the first trial bearing liner around the first attachment passage axis to generate an orientation, as recited in Independent Claim 28, as Doursonian et al. only discloses the single trial insert 33 that is positioned within the cup 16 and the cup 16 is moved relative to the external plate 10.

Accordingly, Applicant respectfully submits that Independent Claim 28, and all of the claims that depend therefrom, are in condition for allowance.

Applicant respectfully submits that the apparatus and method recited in the independent claims and the associated dependent claims, is not anticipated or fairly rendered obvious by any of the cited art. If the Examiner does not agree that all of the claims are in condition for allowance, Applicant respectfully requests that the Examiner contact Applicant's Representative prior to the mailing of any further office actions.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and



favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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